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ATALA, JAMIE JO

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 09/575,858 | Applicant(s) SHIMIZU, YOSHINORI | |
| | Examiner JAMIE JO VENT ATALA | Art Unit 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/1/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. On pages 10-13 applicant argues that Schaffer et al (US 6,934,964) in view of Sezan et al (US 7,178,107) fails to disclose, teach, or suggest "the index picture representing a scene of a program or that the user generated comments associated with each of the plurality of markers represent a text description of the scene" as recited in Claim 1. It is noted that Scheaffer et al discloses the displaying of video thumbnails as seen in Figure 12. The system provides thumbnails of the video program be selected to allow the user a better view of the program to be selected as described in Column 13 Lines 53+ through Column 14 Lines 1-27). Although all of applicant's points are understood the examiner can not agree and the rejection is maintained.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-7, 9-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim(s) 1-7, 9-21 define a transmission medium with descriptive material. While "functional descriptive material" may be claimed as a statutory product (i.e., a "manufacture") when embodied on a tangible computer readable medium, a transmission medium embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible "thing")

and therefore does not fall within one of the four statutory classes of § 101. Rather, “signal” is a form of energy, in the absence of any physical structure or tangible material.

Claim(s) 9-17 and 21 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7,9-15, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffer et al (US 6,934,964) in view of Sezan et al (US 7,178,107).

[claim 1]

In regard to Claim 1, Schaffer et al discloses a reproducing apparatus for receiving contents data and index pictures corresponding thereto from a record medium or transmission (Figure 4) comprising:

- Contents data receiving means for receiving contents data recorded on different record media, said different record media including a plurality of optical media (Figure 4 and described in Column 9 Lines 40+ are the contents being received into the system);
- Index picture generating means for retrieving a picture frame from the contents data to a uniform picture size (Figure 12 shows the index generating means for live thumbnails of video content as described in Column 13 Lines 52-67. Additionally, it is disclosed in Column 14 Lines 1-22 the content data is live or recorded video content from the system);
- Index picture size converting means for converting the size of index pictures generated from contents data having different television systems to a uniform picture size (Column 13 Lines 53+ through Column 14 Lines 1-22 describe the thumbnails wherein the content is from various television systems. As further seen in Figure 12 the index pictures are converted from the television programs to produce a uniformed thumbnail picture size);
- Wherein the uniform picture size of the index picture is smaller than the picture frame size of the contents data (Figure 12 shows the index/thumbnail pictures that represent the content data of broadcast data wherein the frame size is smaller in the index pictures in order to show multiple index pictures of the broadcast);
- Wherein the index pictures is selected by a user from among the contents data (Column 14 Lines 1-30 describe the selecting of content by the user);
- selecting contents data with the displayed index pictures (Column 13 Lines 52+ through Column 14 Lines 1-25 describes the selecting of the contents);

- Picture processing means for processing the first index picture data that is read from said first storage means (Figure 13 shows the image processing means to display video or thumbnails from the storage means as described in Column 14 Lines 1-15);
- Wherein index picture generated from different contents data which have different respective formats and are received from different record media respectively can be displayed together in respective picture frames having the same picture size (Column 14 Lines 1-25 describes the various formats that can be used for generation of index picture);
- each index picture representing a scene of a program (Figure 12 and described in Column 13 Lines 54-67 through Column 14 Lines 1-37); however, fails to disclose
 - Display means for displaying on the display device the index picture formed by said picture processing means and a user generated comment associated with the index picture;
 - Wherein the index pictures generated from the contents data are a plurality of markers, and the user generated comments associated with each of the plurality of markers represent a text description of the scene.

Sezan discloses a system for managing A/V content further comprising:

- Display means for displaying on the display device the index picture formed by said picture processing means and a user generated comment associated with the index picture (Column 5 Lines 3-57 describe the various data associated with each program content wherein program descriptors include data for the system, the user, and the program to provide searching, filtering, browsing of the various programs. The program descriptors are further shown in Figure 22 that is associated with each index picture. Additionally, Figures 5-12 show the display of the

index picture all of which is based on the user generated comment based on the program descriptor information);

- Wherein the index pictures generated from the contents data are a plurality of markers, each index picture representing a scene of a program, and the user generated comments associated with each of the plurality of markers represent a text description of the scene (Column 5 Lines 3-57 describe the program descriptors wherein act as markers to associate text data to each individual index picture/program. The method of providing user generated comments to act as markers is shown in Figure 13 wherein various information associated with the program data is shown and further described in Column 13 Lines 47-67 and Column 14 Lines 1-14).

It is taught by Sezan to use descriptors associated with indexing of the index pictures to provide an effective system that is capable of matching user information with program information to allow for proper recording and searching of programs (Column 8 Lines 1-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the reproducing apparatus that receives and processes index pictures, as disclosed by Schaffer et al, and further teach the system to provide index pictures based on inputted user data, as taught by Sezan, in order to provide an effective and efficient searching, filtering, and browsing of video content.

[claim 2]

In regard to Claim 2, Schaffer et al discloses a reproducing apparatus and method wherein the picture processing comprises converts the component format of the first index picture data (Column 13 Lines 34+ describes the converting of the image into a thumbnail).

[claim 3]

In regard to Claim 3, Schaffer et al discloses a reproducing apparatus wherein said picture processing means has a mono-chrome data generating source and adds mono-

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chrome data generated by the mono-chrome data generating source to the picture frame of the index picture data in the frame shape (Column 14 Lines 15+ describes the changing of the index picture to add or resize the thumbnail for proper displaying and processing).

[claim 4]

In regard to Claim 4, Schaffer et al discloses a reproducing apparatus wherein the picture processing means adds the mono-chrome data to the picture frame of the index picture data so that the pictures of different picture frames sizes are converted into pictures of the same picture frame size (Column 13 Lines 12+ describes the changing of the index picture to add or resize the thumbnail for proper displaying and processing).

[claim 5]

In regard to Claim 5, Schaffer et al discloses a reproducing apparatus wherein said picture processing means enlarges or reduces the picture frame size of the index picture data (Column 13 Lines 12+ describes the enlarging of the index picture frame).

[claim 6]

In regard to Claim 6, Schaffer et al discloses a reproducing apparatus wherein the picture processing means enlarges or reduces the picture frame size of the index picture data so that the pictures of different picture frame sizes are converted into picture of the same picture frame size (Column 13 Lines 12+ describes the changing of the index picture to add or resize the thumbnail for proper displaying and processing).

[claim 7]

In regard to Claim 7, Schaffer et al discloses a reproducing apparatus and method wherein the index picture data includes a first field and second field, and wherein data of one of the first field and second field is not displayed (Column 14 lines 1+ discuss how a first index picture data and second index picture are composed of the

first and second field and the are stored as seen in Figure 12 and only the first picture images are displayed).

[claim 9]

In regard to Claim 9, Schaffer et al discloses a reproducing method for receiving contents data from a record medium or a transmission (Figure 4), the reproducing method comprising:

- Receiving Contents data recorded on different record media, said different record media including a plurality of optical media (Figure 4 and described in Column 9 Lines 40+ are the contents being received into the system);
- Retrieving a picture frame from the content data (Figure 13 shows the retrieving of the content data);
- Generating an Index picture corresponding to a television system of the record medium (Figure 12 shows the index generating means for live thumbnails of video content as described in Column 13 Lines 52-67. Additionally, it is disclosed in Column 14 Lines 1-22 the content data is live or recorded video content from the system);
- Converting the size of the index pictures generated from contents data having different television systems to a uniform picture size (Column 13 Lines 53+ through Column 14 Lines 1-22 describe the thumbnails wherein the content is from various television systems. As further seen in Figure 12 the index pictures are converted from the television programs to produce a uniformed thumbnail picture size);
- Wherein the uniform picture size of the index picture is smaller than the picture frame size of the contents data (Figure 12 shows the index/thumbnail pictures that represent the content data of broadcast data wherein the frame size is smaller in the index pictures in order to show multiple index pictures of the broadcast);

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- Wherein the index pictures is selected by a user from among the contents data (Column 14 Lines 1-30 describe the selecting of content by the user);
- selecting contents data with the displayed index pictures (Column 13 Lines 52+ through Column 14 Lines 1-25 describes the selecting of the contents);
- processing the index picture data according to the selected output (Figure 13 shows the image processing means to display video or thumbnails from the storage means as described in Column 14 Lines 1-15);
- Wherein index picture generated from different contents data which have different respective formats and are received from different record media respectively can be displayed together in respective picture frames having the same picture size a(Column 14 Lines 1-25 describes the various formats that can be used for generation of index picture); however, fails to disclose
 - Display means for displaying on the display device the index picture formed by said picture processing means and a user generated comment associated with the index picture;
 - Wherein the index pictures generated from the contents data represent a plurality of markers of a program and the user generated comments associated with each of the plurality of markers represent a text description of the plurality of markers

Sezan discloses a system for managing A/V content further comprising:

- Display means for displaying on the display device the index picture formed by said picture processing means and a user generated comment associated with the index picture (Column 5 Lines 3-57 describe the various data associated with each program content wherein program descriptors include data for the system, the user, and the program to provide searching, filtering, browsing of the various programs. The program descriptors are further shown in Figure 22 that is associated with

each index picture. Additionally, Figures 5-12 show the display of the index picture all of which is based on the user generated comment based on the program descriptor information);

- Wherein the index pictures generated from the contents data represent a plurality of markers of a program and the user generated comments associated with each of the plurality of markers represent a text description of the plurality of markers (Column 5 Lines 3-57 describe the program descriptors wherein act as markers to associate text data to each individual index picture/program. The method of providing user generated comments to act as markers is shown in Figure 13 wherein various information associated with the program data is shown and further described in Column 13 Lines 47-67 and Column 14 Lines 1-14).

It is taught by Sezan to use descriptors associated with indexing of the index pictures to provide an effective system that is capable of matching user information with program information to allow for proper recording and searching of programs (Column 8 Lines 1-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the reproducing apparatus that receives and processes index pictures, as disclosed by Schaffer et al, and further teach the system to provide index pictures based on inputted user data, as taught by Sezan, in order to provide an effective and efficient searching, filtering, and browsing of video content.

[claim 10]

In regard to Claim 10, Schaffer et al discloses a reproducing method wherein the picture processing comprises converts the component format of the first index picture data (Column 13 Lines 34+ describes the converting of the image into a thumbnail).

[claim 11]

In regard to Claim 11, Schaffer et al discloses a reproducing method wherein said picture processing means has a mono-chrome data generating source and adds mono-

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chrome data generated by the mono-chrome data generating source to the picture frame of the index picture data in the frame shape (Column 14 Lines 15+ describes the changing of the index picture to add or resize the thumbnail for proper displaying and processing).

[claim 12]

In regard to Claim12, Schaffer et al discloses a reproducing method wherein the picture processing means adds the mono-chrome data to the picture frame of the index picture data so that the pictures of different picture frames sizes are converted into pictures of the same picture frame size (Column 13 Lines 12+ describes the changing of the index picture to add or resize the thumbnail for proper displaying and processing).

[claim 13]

In regard to Claim 13, Schaffer et al discloses a reproducing method wherein said picture processing means enlarges or reduces the picture frame size of the index picture data (Column 13 Lines 12+ describes the enlarging of the index picture frame).

[claim 14]

In regard to Claim 14, Schaffer et al discloses a reproducing method wherein the picture processing means enlarges or reduces the picture frame size of the index picture data so that the pictures of different picture frame sizes are converted into picture of the same picture frame size (Column 13 Lines 12+ describes the changing of the index picture to add or resize the thumbnail for proper displaying and processing).

[claim 15]

In regard to Claim 15, Schaffer et al discloses a reproducing method and method wherein the index picture data includes a first field and second field, and wherein data of one of the first field and second field is not displayed (Column 14 lines 1+ discuss how a first index picture data and second index picture are composed of the

first and second field and the are stored as seen in Figure 12 and only the first picture images are displayed).

[claim 19]

In regard to Claim 19, Schaffer et al discloses a reproducing apparatus wherein index pictures of contents data which can be accessed by the contents data receiving means are displayed (Figure 12 shows the displaying of index pictures based on content data).

4. Claims 16, 17, 18, 20, and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffer et al (US 6,934,964) in view of Sezan et al (US 7,178,107) in view of Yamamoto (US 6,904,227).

[claim 16]

In regard to Claim 16, Schaffer et al discloses a reproducing apparatus; however, fails to disclose

- The output type is selected from NTSC or PAL

Yamamoto et al discloses an image data decoding method that compares information for display depending on resolution to be displayed further comprising:

- The output type is selected from NTSC or PAL (Column 8 Lines 58+ through Column 9 Lines 1-20 describe the various display modes that can be selected on output).

Yamamoto et al teaches the use of choosing output type of the system wherein various countries may use different outputs the system can select the appropriate one for the user (Column 8 Lines 59-67). Therefore, it would be obvious to one of ordinary skill in the art to use the reproducing apparatus that generates index pictures for displaying and reproducing, as disclosed by Schaffer et al in view of Sezan et al, and incorporate an output type of NTSC or PAL depending on the display apparatus, as disclosed by

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Yamamoto et al, in order to provide a system with various outputs for the user to choose from for viewing content.

[claim 17]

In regard to Claim 17, Schaffer et al discloses a reproducing method; however, fails to disclose

- The output type is selected from NTSC or PAL

Yamamoto et al discloses an image data decoding method that compares information for display depending on resolution to be displayed further comprising:

- The output type is selected from NTSC or PAL (Column 8 Lines 58+ through Column 9 Lines 1-20 describe the various display modes that can be selected on output).

Yamamoto et al teaches the use of choosing output type of the system wherein various countries may use different outputs the system can select the appropriate one for the user (Column 8 Lines 59-67). Therefore, it would be obvious to one of ordinary skill in the art to use the reproducing apparatus that generates index pictures for displaying and reproducing, as disclosed by Schaffer et al in view of Sezan et al, and incorporate an output type of NTSC or PAL depending on the display apparatus, as disclosed by Yamamoto et al, in order to provide a system with various outputs for the user to choose from for viewing content.

[claim 18]

In regard to Claim 18, Schaffer et al discloses a reproducing apparatus; however, fails to disclose

- a user selects an index pictures, contents data corresponding to the selected index picture are reproduced and displayed.

Yamamoto et al discloses different contents of data further comprising:

- a user selects an index pictures, contents data corresponding to the selected index picture are reproduced and displayed (Figure 8 shows the reproducing of selected index pictures that are selected index pictures. It is further described in Column 12 Lines 42-67 the selecting and reproducing of index pictures).

Therefore, it would be obvious to one of ordinary skill in the art to use the reproducing apparatus that generates index pictures for displaying and reproducing, as disclosed by Schaffer et al in view of Sezan et al, and incorporate the reproducing and selecting of index pictures, as disclosed by Yamamoto et al, providing the same motivation as previously stated in Claim 1.

[claim 20]

In regard to Claim 20, Schaffer et al discloses a reproducing apparatus; however, fails to disclose

- Wherein said different optical media types include a DVD video disc, a video CD, a DC-ROM, and a CD extra disc

Yamamoto et al discloses an image data decoding method that compares information for display depending on resolution to be displayed further comprising:

- Wherein said different optical media types include a DVD video disc, a video CD, a DC-ROM, and a CD extra disc (Figure 6 wherein the optical media types are used for recording as further described in Column 1 Lines 21-32).

Yamamoto et al teaches a system for recording/reproducing on various mediums to allow for various content to be stored allowing for various systems to be used (Column 1 Lines 21-45). Therefore, it would be obvious to one of ordinary skill in the art to use the reproducing apparatus that generates index pictures for displaying and reproducing, as disclosed by Schaffer et al in view of Sezan et al, and incorporate an output to be

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recorded on various optical mediums, as disclosed by Yamamoto et al, in order to provide various recording mediums for recording the video content.

[claim 21]

In regard to Claim 20, Schaffer et al discloses a reproducing apparatus; however, fails to disclose

- Wherein said different optical media types include a DVD video disc, a video CD, a DC-ROM, and a CD extra disc

Yamamoto et al discloses an image data decoding method that compares information for display depending on resolution to be displayed further comprising:

- Wherein said different optical media types include a DVD video disc, a video CD, a DC-ROM, and a CD extra disc (Figure 6 wherein the optical media types are used for recording as further described in Column 1 Lines 21-32).

Yamamoto et al teaches a system for recording/reproducing on various mediums to allow for various content to be stored allowing for various systems to be used (Column 1 Lines 21-45). Therefore, it would be obvious to one of ordinary skill in the art to use the reproducing apparatus that generates index pictures for displaying and reproducing, as disclosed by Schaffer et al in view of Sezan et al, and incorporate an output to be recorded on various optical mediums, as disclosed by Yamamoto et al, in order to provide various recording mediums for recording the video content.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Toriumi (US 6,062,868).

Contact Fax Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE JO VENT ATALA whose telephone number is (571)272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAMIE JO VENT/

Primary Examiner, Art Unit 2621

